

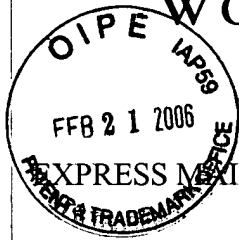
RICK D. NYDEGGER
BRENT P. LORIMER
THOMAS R. VUKSINICK
LARRY R. LAYCOCK
JONATHAN W. RICHARDS
DAVID R. WRIGHT
JOHN C. STRINGHAM
JOHN M. GYNN
CHARLES L. ROBERTS
DANA L. TANGREN
ERIC L. MASCHOFF
CHARLES J. VEVERKA
ROBYN L. PHILLIPS
RICHARD C. GILMORE *
STERLING A. BRENNAN
R. BURNS ISRAELSEN
DAVID R. TODD
DAVID B. DELLENBACH
L. DAVID GRIFFIN
ADRIAN J. LEE
FRASER D. ROY
CARL T. REED



R. PARRISH FREEMAN, JR.
PETER F. MALEN, JR.
L. REX SEARS, PH.D.
WILLIAM R. RICHTER
ROBERT E. AYCOCK
JENS C. JENKINS
MICHAEL B. DODD
KEVIN W. STINGER
WILLIAM J. ATHAY
RYAN D. BENSON
SARA D. JONES
TIGE KELLER
JANNA L. JENSEN
MATTHEW D. TODD
J. LAVAR OLDHAM
MICHAEL J. FRODSHAM
BRETT A. HANSEN
BRETT I. JOHNSON
MATTHEW A. BARLOW
WESLEY C. ROSANDER
ANDREW S. HANSEN
CHAD E. NYDEGGER
JOSEPH G. PIA
CLINTON E. DUKE
RYAN N. FARR
JAMES B. BELSHE
KIRK R. HARRIS
MICHAEL M. BALLARD
DAVID A. JONES
SHANE K. JENSEN
JONATHAN M. BENNS, PH.D.
SCOTT A. WOODBURY
JOHN T. GADD
MARK W. FORD
AARON M. SMITH

VERNON R. RICE §
OF COUNSEL

* Admitted only in California
§ Admitted only in Virginia



WORKMAN | NYDEGGER

INTELLECTUAL PROPERTY ATTORNEYS

1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UTAH 84111
TELEPHONE: (801) 533-9800
FAX: (801) 328-1707
WEBSITE: HTTP://WWW.WNLAW.COM

PATENT APPLICATION
Docket No. 14531.82.2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Dean J. Blackketter, et al.

Serial No.

09/345,223

Filed:

June 30, 1999

For:

METHODS AND APPARATUS FOR
BROADCASTING INTERACTIVE ADVERTISING
USING REMOTE ADVERTISING TEMPLATES

Examiner:

Reuben M. Brown

Mail Stop APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Transmitted herewith are the following for entry in the above-identified application:

- Appeal Brief and Appendix (each in triplicate)

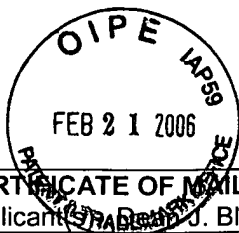
X Enclosed with this transmittal is a Form PTO-2038 in the amount of \$500.00 for filing brief in support of appeal.

X The Commissioner is hereby authorized to charge payment of any other fees associated with this communication or credit any overpayment to Deposit Account No. 23-3178. Duplicate copies of this sheet are attached.

Dated this 21st day of February, 2006.

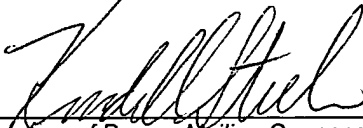
Respectfully submitted,

DAVID R. TODD
Registration No. 41,348
Attorney for Applicant
Customer No. 047973
(801) 533-9800

**CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)**Applicant: **SHARON J. Blackketter, et al.**Docket No.
14531.82.2Serial No.
09/345,223Filing Date
June 30, 1999Confirmation No.
9972Examiner
Reuben M. BrownGroup Art Unit
2611Invention: **METHODS AND APPARATUS FOR BROADCASTING INTERACTIVE ADVERTISING USING REMOTE ADVERTISING TEMPLATES**

I hereby certify that the Transmittal letter (1 page); Appeal Brief (34 pgs) (in triplicate); PTO Form 2038 in the amount of \$500.00; and postcard are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 21, 2006.

Kendell Steele

(Typed or Printed Name of Person Mailing Correspondence)

(Signature of Person Mailing Correspondence)

EV 785 305 217 US

("Express Mail" Mailing Label Number)

KCS0000008105V001.doc



Express Mail Label No. EV 785 305 217 US

PATENT APPLICATION

Docket No. 14531.82.2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of:

Dean J. Blackketter et al.

Serial No.: 09/345,223

Filed: June 30, 1999

For: METHODS AND APPARATUS FOR
BROADCASTING INTERACTIVE ADVERTISING
USING REMOTE ADVERTISING TEMPLATES

Examiner: Reuben M. Brown

)
)
)
)
)
) Art Unit
) 2611
)
)
)
)
)

BRIEF OF APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

On December 19, 2005, Appellant timely filed a Notice of Appeal from the action of the Examiner finally rejecting claims 1-23 in this application. This appeal brief is being filed under the provisions of 37 C.F.R. § 41.37. The filing fee of \$500.00, as set forth in 37 C.F.R. § 41.20(b)(2), is submitted herewith. This brief is being filed on February 21, 2006 and is therefore timely under 37 C.F.R. § 41.37(a)(1) and 35 U.S.C. § 21(b).

REAL PARTY IN INTEREST

The real party in interest is Microsoft Corporation, by way of assignment to WebTV Networks, Inc. (now merged with Microsoft Corporation) from Dean J. Blackketter, Daniel J. Zigmond, and Sandra R. Bernardi, who are the named inventors. The assignment documents were recorded at Reel No. 010549, Frame 0678 in the United States Patent and Trademark Office on February 1, 2000.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

The application was originally filed with claims 1-23. Claims 24-28 were added by Amendment "C" dated August 13, 2004, but were not recognized as being "pending" by the Examiner (and were not rejected) in the final Office Action mailed October 20, 2005. Because it appears that the Examiner has not entered claims 24-28, only claims 1-23 have been appealed.¹

STATUS OF AMENDMENTS

Counsel for the Appellant submitted a "Supplemental Amendment 'C'" pursuant to 37 C.F.R. § 41.33 on February 17, 2006 in order to present claim 14 in better form for consideration on appeal, but this amendment has not yet been entered.

¹ To the extent that claims 24-28 are deemed entered (or are later entered) and are rejected on the same grounds as claims 1-23, Applicant would like to appeal claims 24-28 as well.

SUMMARY OF CLAIMED SUBJECT MATTER

The appealed claims are directed to methods and devices for broadcasting custom advertising over low bandwidth channels through the use of remote advertising templates. There are six independent claims: claims 1, 5, 12-14, and 21. Claim 1 is directed to a method for creating a custom advertisement from the perspective of a receiver. Claim 5 is directed to a similar method drafted from the perspective of the broadcaster. Claims 12 and 13 comprise computer program product claims correspondingly similar to claims 1 and 5, respectively. Claims 14 and 21 are more broadly directed to a system for creating custom advertisements correspondingly similar to the custom advertisements described in the method claims 1 and 5. Thus, the invention claimed in independent claims 1, 5, 12-14, and 21 will be summarized with reference to Figures 4 and 6 below.

The Internet is a worldwide collection of networks and gateways providing access to virtually unlimited information on the World Wide Web (the Web) through the use of high-speed data communication lines and personal computers. (Specification at 1:14-22). Users may also now access the Internet and the Web using an ordinary television (TV) set as a display, a set-top box, and a remote control or wireless keyboard for user input. (Specification at 1:25-2:2). This new method of accessing the Internet has created a desire to enhance broadcast television with Internet content. (Specification at 2:8-10).

Broadcast video signals for display on a television may also contain other data embedded in the video signal. (Specification at 4:17-212). This additional data may be displayed concurrently with the video signal. (Specification at 4:21-23). "For example, analog broadcast signals typically include a portion known as the vertical blanking interval (VBI) that includes a data-service channel for transmitting, among other things, closed-captioning information."

(Specification at 4:23-28). “Unfortunately, the bandwidth of the VBI is limited, so content-rich Web pages or other interactive resources can be slow to broadcast.” (Specification at 5:10-13). This speed limitation is particularly important to advertisers, who must provide such content-rich data in the time span of a fifteen- or thirty-second commercial broadcast. (Specification at 4:13-16). Thus, the VBI bandwidth limitation is a barrier to effectively providing a viewer with content-rich advertising data concurrently with conventional video signal television commercials. (Specification at 4:24-25).

The present invention overcomes this bandwidth barrier limitation by storing advertisement templates on remote receivers. (Specification at 5:28-31). The templates include formatting information and fields into which predefined types of information can be inserted. (Specification at 5:31-6:1). Each template is also assigned a local resource identifier. (Specification at 6:4-6). Thus, only the advertising information to fill in the template must be broadcast during the commercial or television program. This significantly decreases the amount of information that must be broadcast and the time needed to broadcast that information over a low-bandwidth channel. Figure 4 depicts an exemplary communication system 400 utilizing the present invention, and is reproduced here:

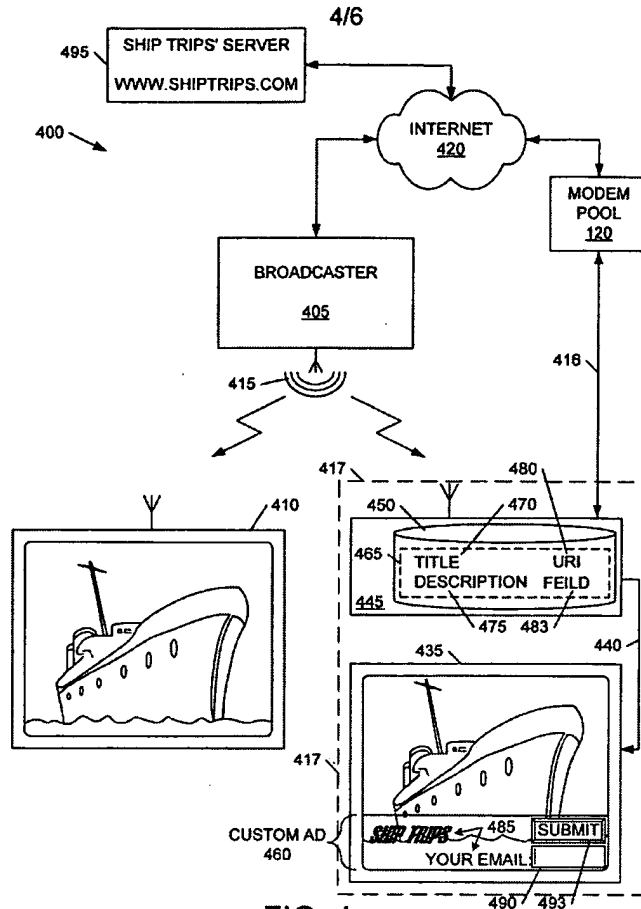


FIG. 4

A receiver 417 receives a broadcast video signal 415 from broadcaster 405. (Specification at 8:2-7). The receiver 417 includes a set-top box 445 connected to a television set 435. (Specification at 8:10-12). The set-top box 445 contains a disk drive 450 that includes an advertisement template 465. (Specification at 9:14-15). By way of example, the advertisement template 465 includes a title field 470, a description field 475, a URI field 480, and a form-entry field 483. (Specification at 9:16-18). The broadcaster 405 can broadcast an advertisement “summary” through a VBI, the advertisement summary containing information to be inserted into each of the title field 470, the description field 475, the URI field 480, and the form-entry field 483. (Specification at 9:28-10:2). The advertisement also contains a resource identifier to identify the template with which the information of the advertisement summary is to

be combined. (Specification at 6:9-12). The set-top box 445 matches the resource identifier of the advertising summary with the corresponding local resource identifier of the template 465, and combines the information of the advertisement summary with the formatting and field information of the template 465 to form a custom advertisement. The advertisement is then combined with the video signal for display on the television 435. (Specification at 9:28-10:2).

“The advertisement summary typically contains far less information than the resulting custom advertisement.” (Specification at 6:20-22). Thus, storing the template including the formatting and field information at the remote receiver 417 significantly reduces the amount of information that must be broadcast over a low-bandwidth channel in order to display a content-rich advertisement during a television program or commercial.

Figure 6, reproduced below, is a flowchart 600 depicting a method performed by a receiver configured to respond to advertisement summaries in accordance with the present invention. (Specification at 17:1-4).

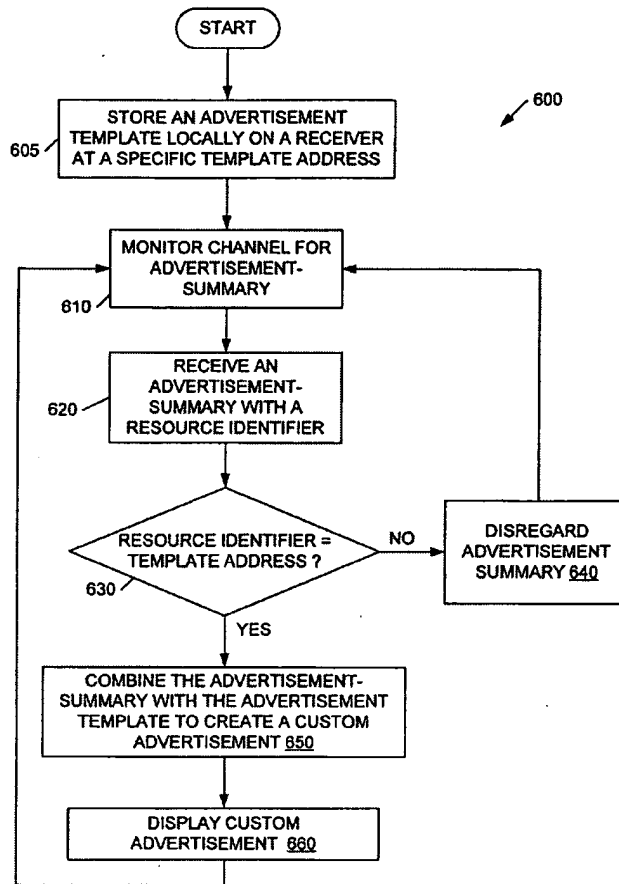


FIG. 6

“First, the receiver stores an advertisement template in local memory (step 605).” (Specification at 17:4-6). “Next, in step 610, the receiver monitors one or more broadcast channels for valid advertisement summaries directed to the stored advertisement template.” (Specification at 17:23-25). “Upon receipt of a valid advertisement summary matching the advertisement template (step 620), the receiver determines whether the resource identifier associated with the advertisement summary matches that of an advertisement template stored in local memory (decision 630). If not, the receiver disregards the advertisement summary (step 640) and continues monitoring the broadcast channel.” (Specification at 18:5-11). “If in step 630 the resource identifier matches that of an advertisement template stored in the receiver, then the receiver combines the information presented in the advertisement summary with the

formatting information provided by the matching advertisement template (step 650). Combining the advertisement summary and advertisement template creates a custom advertisement. The receiver displays the custom advertisement (step 660) and continues monitoring the broadcast channel (step 610).” (Specification at 18:16-24). Importantly, Figure 6 teaches (1) that the advertisement summary is *combined* with the template to *create* a custom advertisement, and (2) that the same template can be used multiple times, and each use may be with a different advertisement summary to display a unique custom advertisement. Only then would the advertisement be combined with another video signal so that it is displayed (step 660).

Independent claims 14 and 21 contain means-plus-function elements governed by 35 U.S.C. § 112, paragraph 6. In accordance with 37 C.F.R. § 41.37(c)(1)(v), applicant identifies the structure described in the specification as corresponding to each claimed function:

| Means-Plus-Function Element in Claim 14 | Corresponding Structure in Specification |
|---|---|
| means for embedding an advertisement summary in a low bandwidth data service channel of the video signal, the advertisement summary comprising custom advertisement information and being addressed to a particular advertisement template; and | “The invention is embodied in machine-readable mediums having stored thereon data representing sequences of instructions. These instructions, when executed by a processor, cause the processor to embed advertisement summaries in a data service channel of a signal.” (Specification at 6:31-7:3). |

| Means-Plus-Function Element in Claim 21 | Corresponding Structure in Specification |
|--|---|
| means for embedding a second set of data in the video signal and broadcasting the second set of data to the receiver, wherein the second set of data represents advertising content addressed to the template; and | “The invention is embodied in machine-readable mediums having stored thereon data representing sequences of instructions. These instructions, when executed by a processor, cause the processor to embed advertisement summaries in a data service channel of a signal.” (Specification at 6:31-7:3). |
| means for combining the first and second sets of data to form a third set of data representing the custom advertisement for display on the receiver; | “Other instruction sequences executed on remote receivers combine the advertisement summaries with local advertisement templates and display the resulting custom advertisements.” (Specification at 6:31-7:3). |

ISSUES TO BE REVIEWED ON APPEAL

1. Did the Examiner err in rejecting claims 1-10, 12-21, and 23 under 35 U.S.C. § 102(e), and claims 11 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Rosser (U.S. Patent No. 6,446,261)?²

ARGUMENT

I. Introduction

All of the claims at issue require a “template” to be stored on a remote receiver. All of the claims at issue further require that the receiver combine information from an advertising “summary” with the stored template to create a custom advertisement for display on the receiver. The Examiner has not identified in the prior art a template stored on a remote receiver as required by the claims, or receivers that combine a template with information from an advertising summary to create a custom advertisement. As such, the Examiner has failed to establish a *prima facie* case of anticipation or obviousness.

II. The Examiner Has Not Established a *Prima Facie* Case of Anticipation or Obviousness for Any Claim

A. The Prior Art Cited by the Examiner Does Not Have a Template Stored on the Receiver, and Does Not Combine a Stored Template with Information from an Advertisement Summary to Create a Custom Advertisement as Required by All Claims

1. All Claims Require a Template to Be Stored on the Remote Receiver and the Receiver to Combine Information from an Advertising Summary to Create a Custom Advertisement

Claim 1 reads as follows:

² Claims 24-28 were not rejected, but apparently were not entered by the Examiner. To the extent that claims 24-28 are deemed to be entered and rejected on the same grounds as claims 1-23, Applicant would like to appeal claims 24-28 as well.

1. A method for creating custom advertisements in a timely manner for display with television broadcast programming, wherein the custom advertisements include custom advertisement information that can be transmitted over a data service channel having a restricted low bandwidth, but wherein the entire custom advertisement cannot be transmitted over the low bandwidth data service channel in a timely manner, the method comprising:

- a. storing, in a receiver, an advertisement template that is identified by a first resource identifier and that includes formatting information corresponding to a custom advertisement that is intended for display during a program that is transmitted over a broadcast signal;
- b. monitoring a low bandwidth data service channel of the broadcast signal for an advertisement summary that is addressed to the advertisement template, wherein the advertisement summary includes a second resource identifier and custom advertisement information; and
- c. creating the custom advertisement by combining formatting information from the advertisement template and the custom advertisement information upon determining the second resource identifier matches the first resource identifier of the information resource, and such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, the custom advertisement being too large to be transmitted over the low bandwidth channel in a timely manner during presentation of the program.

Significantly, paragraph a. of the body of claim 1 requires “storing, in a receiver, an advertisement template.” The specification explains that an advertisement template includes formatting information and fields into which predefined types of information can be inserted. (Specification at 5:31-6:1). Paragraph c. requires “creating the custom advertisement by combining formatting information from the advertisement template and the custom advertisement information . . . such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary.” Thus, a template must be stored

in the local receiver, and the template must be combined with information from the advertising summary to create a custom advertisement.

Claim 5 effectively has the same requirements. Claim 5 reads as follows:

5. A method for broadcasting advertising content for display on a remote receiver during the display of a program, the method comprising:

- a. storing an advertisement template at a remote receiver, wherein the template includes formatting information corresponding to a custom advertisement that is intended for display during a program;
- b. embedding an advertisement summary that is addressed to the advertisement template within a data service channel of a video signal broadcasting the program, the advertisement summary including:
 - i. a resource identifier unique to the advertisement template; and
 - ii. custom advertisement information that is configured to be combined with the formatting information of the advertisement template by the remote receiver to create the custom advertisement, such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, wherein the custom advertisement is too large to transmit over the data service channel in a timely manner during the broadcast of the program; and
- c. broadcasting the signal to the remote receiver, such that remote receiver can create and display the custom advertisement in a timely manner during presentation of the program.

Again, paragraph a. of the body of claim 5 requires “storing an advertisement template at a remote receiver.” Paragraph b.ii. requires “custom advertisement information that is configured to be combined with the formatting information of the advertisement template by the remote receiver to create the custom advertisement.”

Claim 12 also requires a template to be stored on the local receiver, and that the template be combined with custom advertising information to create a custom advertisement:

12. A machine-readable medium having stored thereon data representing sequences of instructions, wherein the instructions, when executed by a processor, cause the processor to embed an advertisement summary in a low bandwidth data service channel of a video signal, the advertisement summary including:

- a. a resource identifier unique to an advertising template residing on a remote receiver; and
- b. custom advertisement information that is configured to be combined with the advertisement template to create a custom advertisement, such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, and wherein the custom advertisement is too large to transmit over the data service channel in a timely manner during a broadcast of a program that is being transmitted over a video signal associated with the data service channel.

Paragraph a. requires “an advertising template residing on a remote receiver.” Paragraph b. requires “custom advertisement information that is configured to be combined with the advertisement template to create a custom advertisement.”

Claim 13 contains requirements virtually identical to those identified in claim 12:

13. A machine-readable medium having stored thereon data representing sequences of instructions, wherein the instructions, when executed by a processor, cause the processor to:

- a. monitor a low bandwidth data service channel of a broadcast video signal for an advertisement summary that is addressed to an advertisement template that is stored by a receiver that is associated with the processor, wherein the advertisement summary includes a resource identifier and custom advertisement information, and wherein a program is being transmitted over the broadcast video signal;
- b. create a custom advertisement by combining the custom advertisement information with an advertisement template upon receipt of the advertisement

summary, such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, the custom advertisement being too large to be transmitted over the low bandwidth channel in a timely manner during presentation of the program; and

c. display the custom advertisement with the program.

Paragraph a. requires “an advertisement template that is stored by a receiver.” Paragraph b. requires the processor “to create a custom advertisement by combining the custom advertisement information with an advertisement template.” Notice that the “display” of the custom advertisement in paragraph c. only occurs once this combination has occurred.

Claim 14 also requires a template to be stored on the local receiver, and that the template be combined with custom advertising information to create a custom advertisement:

14. A system for creating custom advertisements in a timely manner for display with television broadcast programming, wherein the custom advertisements include custom advertisement information that can be transmitted over a data service channel having a restricted low bandwidth, but wherein the entire custom advertisement cannot be transmitted over the low bandwidth data service channel in a timely manner, the system comprising:

a. a broadcast signal source configured to broadcast a video signal in a broadcast video channel;

b. means for embedding an advertisement summary in a low bandwidth data service channel of the video signal, the advertisement summary comprising custom advertisement information and being addressed to a particular advertisement template; and

c. a receiver configured to:

store the advertisement template in local memory, the advertisement [template³] including formatting information for formatting the custom advertisement information into a custom advertisement;

³ During the preparation of the present appeal brief, two typographical errors were found in claim 14. Consequently, “Supplemental Amendment ‘C’” was filed on February 17, 2006 pursuant to 37 C.F.R. § 41.33, requesting entry of an amendment replacing, in both the first and third paragraphs of element c., an occurrence of

tune to the broadcast video channel to receive the video signal and the embedded advertisement summary; and

create the custom advertisement by combining the formatting information from the advertisement [template] with the custom advertisement information, such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, wherein the custom advertisement is too large to be transmitted over the low bandwidth data service channel in a timely manner during presentation of the program.

Paragraph c. of claim 14 requires “a receiver configured to: store the advertisement template in local memory” and to “create the custom advertisement by combining the formatting information from the advertisement template with the custom advertisement information.”

Lastly, claim 21 requires a template to be stored on the local receiver, and that the template be combined with custom advertising information to create a custom advertisement:

21. A system for creating a custom advertisement comprising:
 - a. a broadcast signal source configured to broadcast a program of a specified duration in a broadcast video signal having a data service channel that includes an available data bandwidth;
 - b. a receiver tuned to receive the program and including local memory, wherein the local memory contains a first set of data representing an advertising template;
 - c. means for embedding a second set of data in the video signal and broadcasting the second set of data to the receiver, wherein the second set of data represents advertising content addressed to the template; and

the phrase “advertisement summary” with the phrase “advertisement template” so as to be consistent with the usage of these terms in the rest of the claims. The claim as recited above reflects these two changes in brackets.

- d. means for combining the first and second sets of data to form a third set of data representing the custom advertisement for display on the receiver;
- e. wherein the third set of data is greater than a product of the available data bandwidth and the specified duration of the program; and
- f. wherein the second set of data is less than the product of the available data bandwidth and the specified duration of the program.

Paragraph b. requires “a receiver . . . including local memory, wherein the local memory contains a first set of data representing an advertising template.” Paragraph c. requires a “second set of data . . . wherein the second set of data represents advertising content addressed to the template.” Finally, paragraph d. requires “means for combining the first and second sets of data to form a third set of data representing the custom advertisement.”

In summary, all of the claims require an advertising *template* to be stored on a local receiver. Importantly, a template includes formatting information and fields *into which predefined types of information can be inserted*. (Specification at 5:31-6:1). All of the claims also require the template to be *combined* with advertising information *to create* a custom advertisement.

2. Rosser Does Not Disclose a Template Stored on the Local Receiver or Combining a Template with Advertising Information to Create a Custom Advertisement as the Claims Require

The Examiner rejected all of the claims as being anticipated or obvious based on Rosser. (Office Action mailed October 20, 2005, at 2-7).

Rosser (U.S. Patent No. 6,446,261) discloses a system for “allow[ing] advertisers to target specific ads or indicia to specific viewing profiles.” (Rosser, at Abstract). The focus of Rosser is to display different advertisements or video inserts to different viewers depending on the viewers’ respective individual viewer profiles, which is referred to as “narrow casting.” (Rosser at 3:26-34). In other words, Rosser uses viewer profiles to determine *which*

advertisements and indicia to display on which televisions, but does not concern itself with *creating* advertisements.

Rosser teaches displaying different advertisements at different households depending on the viewer profile of the respective household. (Rosser at 3:26-34). To accomplish this, each set-top box is assigned a local viewer usage profile, and each advertisement includes a viewer usage profile. (Rosser at 7:46-55). The set-top box receives advertisements or video inserts and displays only the advertisements or video inserts that include a viewer usage profile that matches the local viewer user profile of the respective set-top box. (Rosser at 7:46-55). It is important to understand that Rosser discusses two different types of video: (1) the video signal, an example of which would be the live broadcast of a sporting event, and (2) the video inserts, which are the advertisements inserted into the video signal. (*Compare* video signals 40 and 42 of Rosser Fig. 1 and 7:14-20, *with* video inserts 58 and 60 of Rosser Fig. 1 and 7:50-55).

Rosser also teaches that the advertisements may be broadcast in pieces, to be assembled and displayed by the set-top box. (Rosser at 3:16-25). In this embodiment, an upstream “master” part performs the viewer profile recognition and occlusion mask generation, which is sent to the set-top box “slave.” (Rosser at 3:16-25). The set-top box then warps the occlusion mask with the video insert, and combines the insert with the original video signal for display. (Rosser at 3:16-25). Significantly, when an advertisement is broadcast in pieces, there is no creation of a “custom advertisement” in combining those pieces. The pieces are always combined to form a fixed, given advertisement.

In another embodiment, Rosser teaches that the advertisements “may be permanently stored locally in memory device 55, or downloaded, there during or prior to transmission of the

live video transmission in which they are inserted.” (Rosser at 7:45-58). The relevant disclosure is as follows:

The set-top device 44 of the preferred embodiment has, as a minimum, the components of a downstream LVIS system 46, with the ability to strip-off, interpret and use the information mixed in with the video signal by the up-stream LVIS system 16. In particular, the down stream unit 46 is able to use the information generated by the recognition unit 18, the tracking unit 20, and the occlusion mask production unit 22 to perform seamless insertion of still, animated, and live video indicia into the video stream in a way that can make the inserted indicia appear to the end user as if it were part of the original scene 10.

The set-top device 44 of the preferred embodiment is also capable of stripping off, interpreting and using any of a graphic or video, a user enabling key, one or more viewer usage profile keys 120, and a program category code, each of which may have been attached to the video stream by the encoding unit 24 or by central studio site facility 34. In particular, by comparing the viewer usage profile keys 120 with the local viewer usage profile 50, different insertions 58 and 60 may be made on different end users video viewing devices 56. The different insertions may be permanently stored locally in memory device. [sic] 55, or downloaded, there during or prior to transmission of the live video transmission in which they are inserted.

(Rosser at 7:34-58).

The Examiner argues that the audio/video information that may be stored in the terminal as taught by Rosser constitutes a “template.” The Examiner goes on to argue that “the information stripped off of a video signal, (i.e. VBI), that is used to decide which inserts(s) should be made, such as model information, occlusion mask, required viewer profiles, etc.,” reads on the “formatting information” of the claimed templates. (Office Action mailed October 20, 2005 at 2). This interpretation is mistaken.

First, the audio/video information cannot be a template as claimed in the present application because the audio/video information is the complete advertisement, not merely formatting information that must be combined with other information to create an advertisement. Even if Rosser’s stored audio/visual information is less than a complete advertisement, it is the

substantive portion of the advertisement, more akin to the “advertising summary” of the present invention. It is not formatting information. Indeed, the Examiner himself points to the “information that is stripped off of a video signal, (i.e. VBI), that is used to decide which inserts(s) should be made, such as model information, occlusion mask, required viewer profiles, etc.” as the “formatting information,” thereby acknowledging that the audio/video information stored on the set-top box is not a “template” of formatting information to be combined with advertising information.

Second, the stored audio/visual information is not combined with other advertising information (i.e. an advertising summary) to create a custom advertisement. Again the Examiner acknowledges that the information stripped from the video signal in Rosser is merely “used to decide *which insertions(s)* should be made” into the displayed video signal. (Office Action mailed October 20, 2005, at 2). In other words, the stripped information indicates *which* audio/visual advertisement stored on the set-top box should be displayed, *i.e.* the advertisement that best meets the viewer profile identification for that particular set-top box. Rosser does *not* teach that the audio/visual information stored on the set-top box is *combined* with the stripped information to create a *new custom* advertisement.

The Examiner also cites to Rosser at column 10, lines 5-20, as teaching a template. This language states:

In the preferred embodiment, after leaving tuner 72, the signal goes to the decompressor, which, if necessary does any decompressing such as, but not limited to, well known MPEG2 decompression. The output is a base-band video signal 84, which is split into two, one copy of the signal going to a delay line 86, and the other part to the vertical blanking interval decoder 80. The function of vertical blanking interval decoder 80 is to extract the information that was placed there upstream by either LVIS front-end 16 or by central studio site 34. In particular, vertical blanking interval decoder 80 extracts model information 88, occlusion mask 87, the images or videos to be inserted 90, any auxiliary text information 92

associated with the insertion, the required viewer profiles 94 associated with the different insertion videos 90, and different texts 92.

(Rosser at 10:5-20). The Examiner argues that “Rosser teaches that the audio/video (template) may be stored in storage 152. Then various control codes are transmitted in the VBI, which determines which advertisement is displayed in which TV program, and how the advertisement is displayed” (Office Action mailed October 20, 2005 at 3). Again, the Examiner is mistaken.

First, the Examiner is combining inconsistent embodiments of the Rosser specification. The storage 152 cited by the Examiner is described in an embodiment depicted in Figure 4, and the images or videos stripped from the video signal to be inserted 90 cited by the Examiner are described in a different embodiment depicted in Figure 2. The specification expressly states that Figure 4 depicts “an alternative embodiment.” (Rosser, 5:67). The embodiment depicted in Figure 2 and discussed in column 10 teaches that the “vertical blanking interval decoder 80 extracts model information 88, occlusion mask 87, *the images or videos to be inserted 90,*” Thus, in the embodiment of Figure 2, the audio/visual information is *not* previously stored on the set-top box, but is stripped from the broadcast video signal as it is received at the set-top box.

Second, the cited passage in column 10 states that *all* of the component parts of the advertisement, i.e. model information, occlusion mask, images or videos to be inserted, any auxiliary text information, the required viewer profiles and different texts, are stripped from the video signal. Thus, none of these component parts may be construed as a “template” stored on the set-top box as claimed in the present application. Nowhere does Rosser teach that only a portion of an advertisement in Figure 2 may be broadcast and then combined with other portions of the advertisement already existing at the set-top box to create an advertisement.

Moreover, even if memory 152 in Figure 4 does store a portion of an advertisement that is later combined with another portion of that advertisement, memory 152 does not store a “template” for creating a “custom advertisement.” This is because every portion of an advertisement that may be stored in memory 152 is particular to that advertisement. Because every part of every advertisement is particular to that advertisement, it cannot be combined with additional information to create a “*custom* advertisement,” as the claims require. In other words, any portion of an advertisement stored in memory 152 will never be combined with other information to form a variety of advertisements. It will always be combined to form a fixed, given advertisement.

Lastly, the Examiner cites to Rosser column 14, lines 25-58 in support of its argument that Rosser teaches a template. The cited language is as follows:

Another function of central controller 146 may be to make the set-top device act as a downstream or “slave” section of an LVIS system. In particular central controller 146 would use the set-top device’s 44 resources to strip off, interpret, and use the information attached to, or encoded in, the video or television signal by some up stream LVIS system 16. In particular, interpreter 164 would obtain information put in the video, television or data stream by recognition unit 18, tracking unit 20, occlusion mask production unit 22, and camera data interpreter 15 of the front-end or upstream LVIS system 16. The same sort of information provided by the front-end or upstream LVIS system 16 may also have been put in the video, television, or data stream by computer, as for instance, but not limited to, part of some video game, particularly multi-user video applications, or as part of a well known virtual studio set up. The LVIS information extracted by interpreter 164, may be temporarily stored in e [sic] data store 168 for use at a later, appropriate time, or used immediately to extract appropriate material from data store 168, the video and audio storage unit 152, which may be video and audio insertions, and direct it via the appropriate additional desk top functional units.

In addition, central controller 146 will use information about the required viewer usage profile attached to each proposed insert, and have compared it with viewer usage profile 120, stored in viewer usage profile store 170 to decide which insertion to use. The selected insertion is, if necessary, decompressed using video and audio decompression unit 154, before being warped to the appropriate pose by video warping unit 160. Warper 160 is fed appropriate parameters via central

controller 146, which has obtained them via interpreter 164. After warping, the insertion is mixed into the video and audio stream being sent to the end user's set 106 via video and audio mixer 156.

(Rosser at 14:40-58). Here again Rosser teaches that the information stripped by the interpreter is used "to decide *which* insertion to use," i.e. which advertisement to insert into the video signal for display. Once the appropriate insert has been selected according to the viewer profile information, the warper merely prepares that insertion so that it may be seamlessly combined with the video signal.

The Examiner also argues that Rosser teaches creating a custom advertisement because Rosser "discloses that the information that is stored at the subscriber terminal (i.e., video data) is combined with specific format information that is transmitted over the VBI to create a custom image; see col. 3, lines 15-25; co.. [sic] 7, lines 33-45 & col. 10, lines 36-45." (Office Action mailed October 20, 2005, at 4-5). To understand why this assertion is misplaced, it is important to first understand that there are at least two different types of "combinations" potentially at issue here. First, there is the combination of the information in an "advertising summary" with an advertising "template," which are combined to form a "custom advertisement." Second, the custom advertisement can then be combined with a video signal so that the advertisement is displayed with the video signal. All of the claims require the first type of combination: combining a summary and a template to create a "custom advertisement," but it is only *some* of the claims that further require combining that advertisement with a video signal in order to display the advertisement. (See, e.g., claim 13).

The Examiner mistakenly asserts that the combination of Rosser's "specific format information" with a video signal is the first type of combination. It is not. First of all, Rosser does not combine "format information" with a video signal. Instead, Rosser *uses* the "format

information” to combine an advertisement with a video signal to form a “custom image.” The Examiner’s citation to Rosser at column 10, lines 36-45, is representative of the citations relied upon by the Examiner:

Occlusion mask 87 is also fed to a warper 89 which uses model information to warp the occlusion mask into the appropriate pose for the final video. Mixing unit 102 then *combines* the warped occlusion mask, the warped insertion video and text-video *with base-band video 84* which has been delayed by delay line 86 for the time taken to decode and warp the images into place. *The composite output* of mixing device 102, which *is a video signal with an insertion in place* is fed into a channel modulator 104, which converts the base-band video to the form expected by the selected channel of a standard NTSC television set, as is customary.

(Emphasis added). This passage clearly teaches that the “format information” identified by the Examiner is used to prepare an existing advertisement for insertion into the video signal broadcast. At most, this is a disclosure of the second type of combination discussed above: combination of an advertisement with a video signal. The “format information” is *not* the type of formatting information that can be combined with an advertising summary to *create a new custom advertisement* (i.e., the first type of combination), as required by all the claims. Instead, the “custom image” identified by the Examiner is an image of the *base-band video signal broadcast with an inserted advertisement* (the second type of combination). Thus, Rosser does not teach using a template of formatting information to create a new custom advertisement as required by all of the claims.

Importantly, each passage cited by the Examiner teaches that each insert, whether broadcast as a whole or in parts, is individualized. Nowhere does Rosser teach an element stored on a set-top box that may be combined with an advertising summary to create a custom advertisement. In Rosser, every part of every advertisement is particular to that advertisement and therefore cannot qualify as a “template.” Because every part of every advertisement is

particular to that advertisement, it cannot be combined with additional information to create a new *custom* advertisement. In other words, nothing in Rosser indicates that any part of a video insert is interchangeable with another video insert. Consequently, Rosser does not teach the use of templates as claimed in the present invention, and does not teach combining advertising summaries with templates to create custom advertisements.

B. The Examiner Has Not Established a Prima Facie Case of Anticipation Or Obviousness for Claims 21-23 Because the Prior Art Cited by the Examiner Does Not Teach the Bandwidth Limitations of Claim 21

Even if the Examiner has established a *prima facie* case of anticipation and/or obviousness for the other claims, the Examiner has not established a *prima facie* case of anticipation or obviousness for claims 21-23. The Examiner did not address the specific bandwidth limitations contained in claim 21 (and therefore claims 22 and 23). In rejecting claim 21, the Examiner merely states that claim 21 “comprise[s] elements that correspond with subject matter mentioned above in the rejection of claim 1, and [is] likewise treated.” (Office Action mailed October 20, 2005, at 5). Claim 21, however, requires combining first and second sets of data to create a third set of data, “wherein the third set of data is greater than a product of the available data bandwidth and the specified duration of the program; and wherein the second set of data is less than the product of the available data bandwidth and the specified duration of the program.” This specific limitation regarding the relationship between the size of second and third sets of data and the bandwidth is not contained in claim 1, and was not addressed by the Examiner in connection with claims 21-23. Moreover, Rosser does not disclose this limitation of claim 21. Therefore, the Examiner’s rejection of claims 21-23 should be reversed for this reason as well.

CONCLUSION

For the foregoing reasons, Appellant respectfully requests the Board to overturn the Examiner's rejections of the appealed claims 1-23.

Dated this 21st day of February 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David R. Todd". The signature is written in a cursive, flowing style.

RICK D. NYDEGGER

Registration No. 28,651

DAVID R. TODD

Registration No. 41,348

JENS C. JENKINS

Registration No. 44,803

Attorneys for Applicant

Customer No. 047973

CLAIMS APPENDIX⁴

1. (Previously Presented) A method for creating custom advertisements in a timely manner for display with television broadcast programming, wherein the custom advertisements include custom advertisement information that can be transmitted over a data service channel having a restricted low bandwidth, but wherein the entire custom advertisement cannot be transmitted over the low bandwidth data service channel in a timely manner, the method comprising:

- a. storing, in a receiver, an advertisement template that is identified by a first resource identifier and that includes formatting information corresponding to a custom advertisement that is intended for display during a program that is transmitted over a broadcast signal;
- b. monitoring a low bandwidth data service channel of the broadcast signal for an advertisement summary that is addressed to the advertisement template, wherein the advertisement summary includes a second resource identifier and custom advertisement information; and
- c. creating the custom advertisement by combining formatting information from the advertisement template and the custom advertisement information upon determining the second resource identifier matches the first resource identifier of the information resource, and such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, the custom advertisement being too large to be transmitted over the low bandwidth channel in a timely manner during presentation of the program.

2. (Original) The method of Claim 1, further comprising displaying the custom advertisement.

3. (Original) The method of Claim 1, wherein the custom advertisement information includes a third resource identifier.

4. (Original) The method of Claim 1, wherein the first and second resource identifiers are local resource identifiers.

⁴ The claims are presented in their current status. Claim 14 does not reflect "Supplemental Amendment C" submitted pursuant to 37 C.F.R. § 41.33(a) on February 17, 2006, because that Amendment has not yet been entered. Claims 24-28 are presented even though it appears that the Examiner has not entered them.

5. (Previously Presented) A method for broadcasting advertising content for display on a remote receiver during the display of a program, the method comprising:

- a. storing an advertisement template at a remote receiver, wherein the template includes formatting information corresponding to a custom advertisement that is intended for display during a program;
- b. embedding an advertisement summary that is addressed to the advertisement template within a data service channel of a video signal broadcasting the program, the advertisement summary including:
 - i. a resource identifier unique to the advertisement template; and
 - ii. custom advertisement information that is configured to be combined with the formatting information of the advertisement template by the remote receiver to create the custom advertisement, such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, wherein the custom advertisement is too large to transmit over the data service channel in a timely manner during the broadcast of the program; and
- c. broadcasting the signal to the remote receiver, such that remote receiver can create and display the custom advertisement in a timely manner during presentation of the program.

6. (Previously Presented) The method of Claim 5, wherein the signal is broadcast to a second receiver in addition to the first-mentioned receiver, and wherein the information resource does not reside on the second receiver.

7. (Original) The method of Claim 5, wherein the data service channel is a captioning service channel.

8. (Original) The method of Claim 5, wherein the broadcast signal is a National Television Standards Committee (NTSC) video signal including a text or data-service channel.

9. (Original) The method of Claim 8, wherein the data service channel is line 21 of the NTSC video signal.

10. (Original) The method of Claim 9, wherein the broadcast video signal is selected from a group consisting of Phase Alternate Lines (PAL), Sequential Couleur Avec Memoire (SECAM), High Definition Television (HDTV), a Digital Video Broadcasting (DVB) signal, or an Advanced Television Systems Committee (ATSC) signal.

11. (Original) The method of Claim 5, further comprising generating a checksum for the resource identifier and the advertisement summary and inserting the checksum into the advertisement summary.

12. (Previously Presented) A machine-readable medium having stored thereon data representing sequences of instructions, wherein the instructions, when executed by a processor, cause the processor to embed an advertisement summary in a low bandwidth data service channel of a video signal, the advertisement summary including:

- a. a resource identifier unique to an advertising template residing on a remote receiver; and
- b. custom advertisement information that is configured to be combined with the advertisement template to create a custom advertisement, such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, and wherein the custom advertisement is too large to transmit over the data service channel in a timely manner during a broadcast of a program that is being transmitted over a video signal associated with the data service channel.

13. (Previously Presented) A machine-readable medium having stored thereon data representing sequences of instructions, wherein the instructions, when executed by a processor, cause the processor to:

- a. monitor a low bandwidth data service channel of a broadcast video signal for an advertisement summary that is addressed to an advertisement template that is stored by a receiver that is associated with the processor, wherein the advertisement summary includes a resource identifier and custom advertisement information, and wherein a program is being transmitted over the broadcast video signal;
- b. create a custom advertisement by combining the custom advertisement information with an advertisement template upon receipt of the advertisement summary, such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, the custom advertisement being too large to be transmitted over the low bandwidth channel in a timely manner during presentation of the program; and
- c. display the custom advertisement with the program.

14. (Previously Presented) A system for creating custom advertisements in a timely manner for display with television broadcast programming, wherein the custom advertisements include custom advertisement information that can be transmitted over a data service channel having a restricted low bandwidth, but wherein the entire custom advertisement cannot be transmitted over the low bandwidth data service channel in a timely manner, the system comprising:

- a. a broadcast signal source configured to broadcast a video signal in a broadcast video channel;
- b. means for embedding an advertisement summary in a low bandwidth data service channel of the video signal, the advertisement summary comprising custom advertisement information and being addressed to a particular advertisement template; and
- c. a receiver configured to:
 - store the advertisement template in local memory, the advertisement summary including formatting information for formatting the custom advertisement information into a custom advertisement;
 - tune to the broadcast video channel to receive the video signal and the embedded advertisement summary; and
 - create the custom advertisement by combining the formatting information from the advertisement summary with the custom advertisement information, such that the custom advertisement embodies a combination of both the advertisement template and the advertising summary, wherein the custom advertisement is too large to be transmitted over the low bandwidth data service channel in a timely manner during presentation of the program.

15. (Original) The system of claim 14, wherein the receiver is configured to combine information provided in the advertisement summary with formatting information provided in the advertisement template to produce a custom advertisement.

16. (Original) The system of claim 14, wherein the information provided in the advertisement summary includes a hyperlink.

17. (Original) The system of claim 14, wherein the advertisement template further comprises a time stamp.

18. (Original) The system of claim 14, wherein the advertisement summary includes a time-out attribute defining a time to end the custom advertisement.

19. (Original) The system of claim 14, wherein the advertisement summary includes an attribute that determines at least one of the color, font style, font size, transparency, texture, advertisement size, and advertisement position of the custom advertisement.

20. (Original) The system of claim 14, wherein the advertisement summary includes a view attribute that determines whether the custom advertisement is displayed automatically without user intervention.

21. (Previously Presented) A system for creating a custom advertisement comprising:
- a. a broadcast signal source configured to broadcast a program of a specified duration in a broadcast video signal having a data service channel that includes an available data bandwidth;
 - b. a receiver tuned to receive the program and including local memory, wherein the local memory contains a first set of data representing an advertising template;
 - c. means for embedding a second set of data in the video signal and broadcasting the second set of data to the receiver, wherein the second set of data represents advertising content addressed to the template; and
 - d. means for combining the first and second sets of data to form a third set of data representing the custom advertisement for display on the receiver;
 - e. wherein the third set of data is greater than a product of the available data bandwidth and the specified duration of the program; and
 - f. wherein the second set of data is less than the product of the available data bandwidth and the specified duration of the program.
22. (Original) The system of claim 21, wherein the first set of data is less than one half of the product of the available data bandwidth and the specified duration of the program.
23. (Original) The system of claim 21, wherein the program is a television commercial advertisement.
24. (Previously Presented – Not Entered) A method as recited in claim 1, wherein the advertising summary is broadcast as a trigger.
25. (Previously Presented – Not Entered) A method as recited in claim 5, wherein the advertising summary is broadcast as a trigger.
26. (Previously Presented – Not Entered) A machine-readable medium as recited in claim 12, wherein the advertising summary is embedded as a trigger.

27. (Previously Presented – Not Entered) A machine-readable medium as recited in claim 13, wherein the advertising summary is broadcast as a trigger.

28. (Previously Presented – Not Entered) A method as recited in claim 14, wherein the advertising summary is embedded as a trigger.

EVIDENCE APPENDIX

Not applicable.

RELATED PROCEEDINGS APPENDIX

Not applicable.

DRT0000000975V001